



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BANNER & WITCOFF, LTD.
TEN SOUTH WACKER DRIVE
SUITE 3000
CHICAGO IL 60606

COPY MAILED
DEC 05 2008
OFFICE OF PETITIONS

In re Application of :
Lin Wang et al. :
Application No. 10/687,498 : DECISION ON PETITION
Filed: March 25, 2004 :
Attorney Docket No. 006401.00418 :
:

This is a decision on:

- (1) the petition under 37 CFR 1.183 requesting a waiver to permit a refund of the Time Extension Fees paid February 25, 2008 and
- (2) the petition under 37 CFR 1.181, which has been properly considered as a petition under 37 C.F.R. 1.181(a) asking the Director to exercise his supervisory authority to refund the Time Extension Fees paid February 25, 2008.

These petitions were filed concurrently on February 25, 2008.

The petition under 37 CFR 1.183 is **dismissed** and the petition under 37 CFR 1.181 is **granted**.

A Notice of Appeal (Notice) and Pre-Appeal Brief Request for Review (Request) were filed July 23, 2007. 37 CFR 41.37 required the filing of an appeal brief (accompanied by the fee required by 37 CFR 41.20(b)(2)) within two-months of the filing date of the Notice. An extension of time pursuant to the provisions of 37 CFR 1.136(a) was available. An appeal brief (and fee) was filed in accordance with 37 CFR 41.37 on February 25, 2008 with a five month extension of time under 37 CFR 1.136(a). The Request was not decided. Petitioner now requests a refund of the five month extension of time fee paid February 25, 2008 since the Request was not decided before the expiration of the period in which to file an appeal brief under 37 CFR 41.37. Petitioner contends that such a decision might have determined that the application was in condition for allowance and the filing of an appeal brief was unnecessary or that an extension of time would not have been payable upon filing the appeal brief.

37 CFR 1.183 allows for the waiver of a regulation that is not a requirement of the statutes when there is an extraordinary circumstance in which justice requires such a waiver. The petition does not clearly identify a regulation for the Director to waive, but the waiver of an extension of time

under 37 CFR 1.136 and the associated fees is discussed. Regardless of the regulation to be waived, the Official Gazette Notice (Notice) of July 12, 2005 establishing the Pre-Appeal Brief Conference Pilot Program (Program) indicated that any existing USPTO rule that is inconsistent with the Program is waived. However, the waiver of a rule will not achieve the relief requested by petitioner since the requested refund is not prevented by a rule. The present circumstances are appropriately addressed under the Director's supervisory authority pursuant to 37 CFR 1.181.

In this regard, the July 12, 2005 Notice established that when a request for pre-appeal brief review is filed with the notice of appeal, such as the July 23, 2007 Request, the period of time for filing the appeal brief will be the later of the two-month period set in 37 CFR 41.37(a) or one month from the mail date of the decision on the request. Since a decision had not yet been rendered on the July 23, 2007 Request, a period for filing the appeal brief was not set. Accordingly, applicants were not required to file the appeal brief when they did or pay an extension of time fee. The extension of time fee was paid by mistake and will be credited to deposit account 19-0733 as requested.

Any questions concerning this decision may be directed to Christopher Bottorff at (571) 272-6692.



David Bucco
Petitions Examiner
Office of Petitions